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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,082	12/08/2005	Jean-Pierre Arnaud	446,039	7463
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HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER				
NATHAN, SHYAM				
ART UNIT		PAPER NUMBER		
1611				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,082

Applicant(s)

ARNAUD ET AL.

Examiner

SHYAM NATHAN

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1611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-893)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Instant claims 1-16, and 19 are pending in this Office Action. Claims 17 and 18 have been cancelled. This is the first Office Action on the merits of the claims.

Priority

The earliest effective US filing date afforded the instantly claimed invention is 10/02/2003, the filing date of application PCT/FR03/02898.

Claim Objections

Claim 1 is objected to because of the following informalities: polyglyceryl acrylate in line 3 of claim 1 should be polyglyceryl acylate. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 and 19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a combination of at least three substituents;" however there are 5 substituents that follow. It is unclear if Applicant is intending to recite a Markush ("selected from") or whether Applicant is intending to define three sub-groups, thus the claims are indefinite.

Claim 9 recites the limitation "these three constituents completing the agent" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 provides for the use of the gelling and/or thickening agent, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-16, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rerek et al. (US Patent NO. 5,849,315; issued Dec.15,1998), Lezdey et al. (US Patent No. 6,428,791; issued Aug. 6, 2002) Krzysik et al. (US Patent no. 6,440,437; Issued Aug. 27, 2002) Lu et al (US pub No. 203/0091665; Pub date May15,2003) Dobler et al. (US Patent NO. 5,985,821; issued Nov.16, 1999) and in further view of Gers-Barlag et al (US patent No. 5,876,702; Issued Mar. 2, 1999)

Instant claims 1-16 are drawn to a gelling and/or thickening agent characterized in that it is formed from a combination of at least three constituents: a polyacrylamide and ammonium acrylate copolymer and/or anionic acrylic copolymer, phospholipids of plant origin, and a polyglyceryl acrylate, characterized in that it contains a copolymer concentration ranging from 20 to 50% of the total weight of the agent, a phospholipid concentration ranging from 6 to 40% and a polyglyceryl acrylate concentration ranging from 5 to 40%, in which the copolymer is present at a concentration ranging from 50 to 80% in a dilute form in a hydrogenated polyisobutene containing from 40% to 60% of active material, in which the phospholipids are in the form of lecithins which are present in a concentration ranging from 10% to 40% of the total weight of the agent, in which the lecithins contain less than 40% oil and more than 60%

phospholipids, in which the acrylic copolymer is a sodium acrylate/acryloyldimethyl taurate copolymer.

Rerek teaches of an emulsifier compositions and a process for producing emulsifier compositions for skin care formulations particularly to an emulsifier composition which will form a lamellar liquid crystal gel network in an oil-in water system which comprises a anionic copolymer (Carbopol 5984, Abstract and column 4, ex.8) lecithin claims 1-3 and 6), lecithin, 3-40% by weight (claims 1-3 and 6) and glyceryl stearate, 15-30% by weight (claims 1 and 6) and water, 68% by weight. The lecithin could be the soybean oil (Abstract and column 3, ex 2,4-6,8) which could make up more than 60% of the lecithin weight. (the lower limit of the oil could be less than 40% which can be 0%) . The composition of Carbopol is not immediately envisaged in the composition, however Rerek suggests the use of Carbopol in the invention. One would be motivated to use Carbopol because it is an anionic acrylic copolymer and a viscosity agent and rerek teaches the use of it in the composition.

But Rerek does not teach of a polyacrylamide and polyglyceryl-10 stearate, which is a polyglyceryl acylate. A copolymer present in dilute form in a hydrogenated polyisobutene and a sodium acrylate/acryloyldimethyl taurate copolymer as well as a particle size of between 1-11 Microns.

Lezdey et al. teaches of a lubricant which can be used for topical application in the form of an emulsion (Abstract and column 2, lines 50-60) that use polyacrylamides as hydrophilic

gelling agents (Abstract and column 2, lines 45-50) and as preferred synthetic polymers (Abstract and column 4, lines 60-65)

It would have been obvious of one skilled at the time the invention was made to have added the polyacrylamide to the Rerek composition because Lezdey teaches them as hydrophilic gelling agents and synthetic polymers in a lubricant, gelling emulsion. One would have been motivated to do so because Rerek uses synthetic polymers and gellents like Carbopol in the invention, therefore, it would be obvious to add another gelling agent or synthetic polymer for dermatological effects.

Krzsik teaches of a cosmetic wipe that contains an oil-in-water emulsion composition used in cosmetics on skin (Abstract and column 3, lines 35-45) that contains emulsifying surfactants that can include Glyceryl stearate and polyglyceryl-10 Stearate (Abstract and column 11, line 50)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize polyglyceryl-10 Stearate in exchange for glyceryl stearate in the composition of Rerek, because they are both surfactants having an HLB range of about 7-18 in an oil and water emulsion. (Krysik; Abstract and column 8, lines 5-10)

Dobler teaches of a gel form of fragrance that can be applied to the skin (Abstract and column 1, lines 50-65) that contains organic or inorganic polymers or a combination of such

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polymers to add to the viscosity of the composition, which include ammonium acrylates copolymer and hydrogenated polyisobutene. (Abstract and column 3 and 4)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize ammonium acrylates copolymer and hydrogenated polyisobutene in the composition of Rerek because they would both add viscosity to the Rerek gel composition. One would have been motivated to do so since the Rerek composition already contains Carbopol which is a viscosity agent, therefore, it would be obvious to add other viscosity agents for dermatological effects.

Lu teaches of a topical composition that provides rejuvenation benefits to the skin that can be applied topically [0019] as an oil/water emulsion that utilizes sodium acrylate/acryloyldimethyl taurate, as an emulsion stabilizer/viscosity modifier. [0072-0089, ex.2].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize utilizes sodium acrylate/acryloyldimethyl taurate in the composition of Rerek because they would both add viscosity to the Rerek gel composition. One would have been motivated to do so since the Rerek composition already contains Carbopol which is a viscosity agent, therefore, it would be obvious to add other viscosity agents for dermatological effects.

Gers-Barlag et al. teaches of a O/W emulsion wherein the particle size of the oil droplets essentially being determined by the concentration of the emulsifier or emulsifiers employed that a higher emulsifier concentration has the effect of a smaller droplets and a lower emulsifier concentration leads to larger droplets (Abstract and column 6, lines 4-15). for W/O emulsions the concept would be same except it would affect the particle size of the water droplets. Therefore, it would have been routine experimentation for one of ordinary skill in the art to manipulate the particle size in the emulsion by increasing or decreasing the concentration of the emulsifying agents in Rerek to obtain an average particle size of 1-11 microns.

Regarding the relative amount of components anionic acrylic copolymer, hydrogenated polyisobutene, and gelling/thickening agent recited in Applicants' dependent claims; the amount of components anionic acrylic copolymer, hydrogenated polyisobutene, and gelling/thickening agent in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of components anionic acrylic copolymer, hydrogenated polyisobutene, and gelling/thickening agent needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of components anionic acrylic copolymer, hydrogenated polyisobutene, and gelling/thickening agent would have been obvious at the time of applicant's invention.

Further, it would have been obvious to one skilled in the art at the time of invention to determine all optimum and operable conditions (e.g. the gelling /thickening agents), because such conditions are art-recognized result-effective variables that are routinely determined and optimized in the art through routine experimentation. ("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). *See* MPEP § 2145.05).

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHYAM NATHAN whose telephone number is (571)270-5753. The examiner can normally be reached on Mon-Thurs 8:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SN

/Andrew D Kosar/
Primary Examiner, Art Unit 1654